

REMARKS/ARGUMENTS

In response to the Office Action mailed November 18, 2003, Applicants amend their application and request reconsideration in view of the amendments and the following remarks. In this amendment, Claims 1 and 9 are to be amended, Claims 18-31 were previously cancelled without prejudice and no claims have been added so that Claims 1-17 are currently pending. No new matter has been introduced.

Claims 1 and 9 were objected to because of informalities. Applicants respectfully submit that amended claims 1 and 9 clearly set forth the invention. Any tubular structure having a finite thickness has different radii of curvature as the radius changes. The marker housing is formed from the same material as the tubular structure; accordingly, its outer surface has the same radius of curvature as that of the outer surface of the tubular structure and its inner surface has the same radius of curvature as that of the inner surface of the tubular structure. The marker insert is forced into its position as is explained in detail in the specification.

Claims 1-14, 16 and 17 were rejected as being unpatentable over WO 97/33534 to Globerman et al. (Globerman) in view of U.S. Patent No. 5,632,771 to Boatman et al. (Boatman). Claim 15 was rejected as being unpatentable over Globerman in view of Boatman and further in view of U.S. Patent No. 6,022,374 to Imran (Imran). These rejections are respectfully traversed.

Globerman discloses stents having radiopaque markers. Broadly, Globerman discloses marking the edges of stents by inserting rivets through the ends or edges of the stents. In one embodiment, the rivet comprises a short rod made from a radiopaque material which is compressed into an opening of the stent. The compression is in the axial direction thereby causing a circumferential force that enables the rivet to be held in the opening (Figure 3). In another embodiment, the rivet comprises edges such that after compression, the rivet is secured due to friction between the edges of the rivet and the inner walls of the opening (Figure 4). In yet another embodiment, the marker rivet is made with chamfered edges. After the rivet is inserted into the opening of the stent, the stent is pressed at certain points so the marker rivet cannot be displaced from the stent (Figure 5). In yet another embodiment, the rivet comprises a head portion (Figure 6) or two head portions (Figure 7) that protrude from the opening and past the opening. The hole or opening in each of these embodiments is formed in the end loop of the stent as illustrated in Figure 1, it does not extend beyond the end of the stent. In alternate embodiments, the openings and rivets may be oval or non-round.

In each of the above-described embodiments, the marker rivets are completely surrounded by the stent material. However, in an alternate embodiment, the marker may extend from the stent as illustrated in Figure 9. In other words, the marker rivet is not completely surrounded by the stent.

Boatman discloses a stent having a predetermined pattern. Opposite stent ends include eyelets for positioning radiopaque

markers therein or fixedly attaching them thereto. Radiopaque markers are affixed by placing a 0.01 inch diameter piece of radiopaque material in the eyelet and heating the material to melt it in place. Alternatively, radiopaque markers are positioned in the eyelets by crimping or any other well-known fastening techniques.

Imran discloses a stent with radiopaque markers. The markers are built into the framework of the stent in such a manner as not to interfere with stent operation.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

In re Vaeck, 947 F.2d,488,20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490F.2d 981, 180 USPQ 580 (CCPA 1074). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

None of the references, whether taken alone or in combination, discloses or remotely suggests a marker having a housing that is integral to and extends from the end of a substantially tubular member as claimed in amended independent claims 1 and 9. None of the references discloses or suggests a marker housing having inner and outer surfaces with radii of curvature equal to that of the substantially tubular member and defining an opening that is conical in the radial direction with the outer surface of the marker housing having a diameter larger

than the diameter of the inner surface of the marker housing. None of the references discloses or suggests a marker insert having an inner surface with a radius of curvature equal to that of the inner surface of the tubular member and an outer surface with a radius of curvature less than that of the outer surface of the substantially tubular member such that it is recessed. All of these claimed features provides for a low profile device.

Given that the references fail to disclose or suggest all of the claimed features, there is no *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Applicants would be willing to interview the present case if the Examiner so desires.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,



Carl J. Evens
Reg. No. 33,874
Attorney for applicant

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2518